

REMARKS

Applicant elects claims 6-10 and withdraws claims 1-5 in response to the election requirement.

The Examiner has rejected claims 6-10 under 35 U.S.C. 103(a), finding that the claims are obvious in light of Burns combined with Wheeler. Applicant respectfully disagrees with this rejection. A *prima facie* case of obvious has not been established, as there is no suggestion or motivation to combine these references. See MPEP Section 2143. Without a motivation to combine, a *prima facie* case of obviousness is improper. See In re Roufet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Wheeler is not concerned with a technical field similar to that of Applicant's claimed invention. Applicant's invention relates to injection molded bottle closures with markings molded into at least one end portion of the bottle closure during the injection molding process. Wheeler relates to pressing wood or other cellulosic fibers and including pressing decorative patterns into the wood during the pressing process. Applicant specifically describes the problems with using wood cork as a material for bottle closures, including cork taint and variations in the color, compressibility, and rigidity of cork. Wheeler teaches away from the claimed invention in that it is used only to impress designs into wood, which is described as a problem with the prior art. As such, there is no motivation or reason to combine the two cited references. A *prima facie* case of obviousness has not been established and Applicant believes the claims are patentable over the cited art.

The application has been amended to correct minor informalities, and to more particularly point out and distinctly claim the subject matter which Applicant regards as the invention so as to place the application, as a whole, into a prima facie condition for allowance. Great care has been taken to avoid the introduction of new subject matter into the application as a result of the foregoing modifications.

Accordingly, the purpose of the claimed invention is not taught nor suggested by the cited references, nor is there any suggestion or teaching that would lead one skilled in the relevant art to combine the references in a manner that would meet the purpose of the claimed invention. Because the cited references, whether considered alone, or in combination with one another, do not teach nor suggest the purpose of the claimed invention, Applicant respectfully submits that the claimed invention, as amended, patentably distinguishes over the prior art, including the art cited merely of record.

Based on the foregoing, Applicant respectfully submits that claims 6-10 are in condition for allowance at this time, patentably distinguishing over the cited prior art. Accordingly, reconsideration of the application and passage to allowance are respectfully solicited.

The Examiner is respectfully urged to call the undersigned attorney at (515) 288-2500 to discuss the claims in an effort to reach a mutual agreement with respect to claim limitations in the present application which will be effective to define the patentable subject matter if the present claims are not deemed to be adequate for this purpose.

Respectfully submitted,

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